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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/661,612   | 09/15/2003  | Patrick J. Coyne     | 0005-0005           | 9305             |
| 36878 7590 05/12/2009<br>MH2 TECHNOLOGY LAW GROUP, LLP<br>1951 KIDWELL DRIVE<br>SUITE 550<br>TYSONS CORNER, VA 22182 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| PARDO, THUY N  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2627   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/661,612

**Applicant(s)**

COYNE ET AL.

**Examiner**

Thuy N. Pardo

**Art Unit**

2627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 1/21/2009, 4/20/2009, and 4/30/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7-25 and 29-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-25 and 29-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/20/2009; 4/16/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In the amendment filed January 21, 2009 in response to Examiner's Office Action has been reviewed. Claims 1-3, 7-25 and 29-70 are pending in the application. Claims 4-6 and 26-28 are canceled, claims 1, 12, 23, 34, 45 are amended, and claims 56-70 are added. This Office Action is made Non-Final.

2. Applicant's Affidavit or Declaration Under 37 CFR 1.131 filed on January 21, 2009 to submit a declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the Carol reference 6,714,928 on which the rejection is based. Applicant shows the facts of establishing reduction to practice as early as July 28, 1998 prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration from prior January 01, 2001 to December 10, 2001 (filing date of Provisional Application 60/337,158). Therefore, Applicant's declaration under 37 CFR 1.131 is appropriate to overcome the rejection.

***Terminal Disclaimer***

3. The terminal disclaimer filed on April 30, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent

Application No. 10/315,196 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-3, 7-25 and 29-70 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

I. Claims 1-3, 7-25 and 29-55 are rejected under 35 U.S.C. 102(c) as being anticipated by Pallmann US Paten No. 6,094,684.

As to claim 23, Pallmann teaches the invention substantially as claimed [see the abstract], comprising:

a. maintaining data in a first software application in a first portable format [HTML format, col. 11, lines 1-25];

b. maintaining data in a second software application in a second format other than said first format [text format, col. 11, lines 1-25; 106 of fig. 2];

c. communicating the data from said first software application to a professional services project management application through a first server [host computer logon, fig. 23; 106 of fig. 2];

d. communicating the data from said second software application to said professional services project management application through said first server means cooperating with said second server [format conversion, col. 11, lines 1-25 through FTP server and ODBC server, 1314, 1320 of fig. 13]; and

e. providing the data to the user through said professional services project management application [Delivery: "email as an attachment to recipients", 1354 of fig. 13].

As to claims 1, Pallmann teaches the invention substantially as claimed. Pallmann further teaches said professional service practice management application further comprising an interface for communicating the data to the user [302, 316 of fig. 3; fig. 12, 16-17].

As to claims 12, 34 and 45, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 2, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that said professional services project management application comprises a shareware application [].

As to claim 3, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that said professional services project management application comprises a Lotus Notes database [col. 7, lines 1-26].

As to claims 13-15, 24, 25, 35-39 and 46-50, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 7, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that said first software application is adapted to maintain data selected from the group consisting of: docketing, word processing, Notes database, document management, email, records, forms, workflow, conflicts, expense, budgeting, risk management, project management, database, imaging, and reporting data [fig. 21].

As to claims 8-11, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that said second software application is adapted to maintain data selected from the group consisting of: accounting, time, billing, expense, cost, and budgeting data, accounting data, or a TMC accounting system [fig. 2].

As to claims 18-22, 29-33, 40-44 and 51-55, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 56, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that the data in said second format is incompatible for use by said first software application [the data in said second format is incompatible for use by said first software application without format conversion, ab].

As to claim 57, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that the data in said first portable format cannot be accessed by said second software application [first portable format cannot be accessed by said second software application without format conversion, ab].

As to claim 58, Pallmann teaches the invention substantially as claimed. Pallmann further teaches that the data in said second format is retrieved via an ODBC-compliant driver [col. 10, lines 11-36].

As to claims 59-70, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-3, 7-25 and 29-70 have been considered but are moot in view of the new ground(s) of rejection.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy N. Pardo whose telephone number is 571-272-4082. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thuy N. Pardo/  
Primary Examiner, Art Unit 2627